R E M A R K S

1. Claims 1-95 are pending in this Application. Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the discussion that follows.

The abstract has been objected to. Claims 81-84 and 92-95 have been objected to under 37 CFR §1.75(c) as being in improper form. Claims 4-6, 8-70 and 74-95 have been rejected under 35 U.S.C. §112, first paragraph. Claims 4-6, 8-70 and 74-95 have been rejected under 35 U.S.C. §112, second paragraph. Claims 1-95 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,263,314 to Donner. After a careful review of the claims (as amended), it has been concluded that the rejections are improper and should be withdrawn.

2. The abstract has been objected to. In response, the abstract has been amended to conform to MPEP §608.01(b).

3. Claims 81-84 and 92-95 have been objected to under 37 1.75(c) as being in improper form. In response, claim 81 has been amended to depend in the alternative.

4. Claims 4-6, 8-70 and 74-95 have been rejected under 35 U.S.C. 112, first paragraph. In this regard, the Examiner asserts that "The applicant's specification does not disclose adequate structure for performing the recited function" (Office Action of 7/28/04, page 3). However, "The first paragraph of §112 requires nothing more than objective enablement . . . How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is of no importance" (In re Marzocchi & Horton, 169 USPQ 367 (CCPA, 1971).

The Examiner asserts that "The applicant has not defined how the security measure factor is determined" (Office Action of 7/28/04, page 3). However, the security measures factor and its determination are clearly described by broad terminology in the specification on pages 18-32. Since the use of broad terminology clearly satisfies the requirements for patentability, the rejection is believed to be improper and should be withdrawn.

The Examiner asserts that "The applicant has failed to provide the mathematical equations used to perform calculations. How are the security threats factors calculated" (Office Action of 7/28/04, page 3). However, the threshold values are discussed in the specification, in broad terms, as are the net present value of a trade secret, the economic benefit, negative know-how, weighted values of the six factors and the use of logical and

mathematical equations. Since the use of broad terminology clearly satisfies the requirements for patentability, the rejection is improper and should be withdrawn.

In addition, "As a matter of Patent Office Practice, then, a specification disclosure which contains a teaching of the manner and process of making an using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied upon for enabling support" (In re Marzocchi & Horton, 169 USPQ 367 (CCPA, 1971). Since the Examiner has failed to provide a basis for doubting the objective truth of the specification, the rejection is believed to be improper and should be withdrawn.

5. Claims 4-6, 8-70 and 74-95 have been rejected under 35 U.S.C. 112, second paragraph. In this regard, the Examiner has based the rejection upon invention details which are not present within the claims. However, there is no requirement that the claims be so limited.

In this regard, the Examiner queries "how is the indexing performed". In this regard, the process of indexing is described in numerous places within the specification (e.g., page

16, 17, etc.). As such, the process of indexing is objectively enabled by the specification. Since the specification clearly enables indexing, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to indexing are clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "how are trade secret drafts converted into trade secret application". In this regard, the process of converting trade secret drafts is described in general within the specification (e.g., page 35). As such, the process of converting trade secret drafts is objectively enabled by the specification. Since the specification clearly enables the converting of trade secret drafts, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to indexing clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "How are the security measure specified". In this regard, security measures are described in general within the specification (e.g., page 3). As such, the process specifying security measures is objectively enabled by

the specification. Since the specification clearly enables the use of security measures, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to indexing clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "How are security threats specified". In this regard, the process of dealing with security threats is described in general in numerous locations within the specification (e.g., pages 6, 16-19, etc.). As such, the process of dealing with security threats is objectively enabled by the specification. Since the specification clearly enables the processing of dealing with security threats, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to indexing clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "What are the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts". In this regard, the six factors of a trade secret (as enumerated in Section 757 of the First Restatement of Torts) discussed in general in numerous locations

within the specification (e.g., page 3, 20, 23, 32, etc.). As such, the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts are objectively enabled by the specification. Since the specification clearly enables the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to indexing clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "How are the values weighted". In this regard, the weighting of the six factors is discussed in general in numerous locations within the specification (e.g., page 5, 8, 20, etc.). As such, the weighting of the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts is objectively enabled by the specification. Since the specification clearly enables the weighting, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to indexing clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "What is a combinational trade secret". In this regard, combinational trade secrets are discussed in general within the specification (e.g., page 17). As such, combinational trade secrets are objectively enabled by the specification. Since the specification clearly enables combinational trade secrets, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to indexing clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "What constitutes negative know-how". In this regard, negative know-how is discussed in general in numerous locations within the specification (e.g., pages 4, 17, etc.). As such, the concept of negative know-how is objectively enabled by the specification. Since the specification clearly enables negative know-how, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to negative know-how clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "How does one create a specification of the type trade secret using alphabetic, numeric,

or alphanumeric codes". In this regard, the use of alphabet, numeric, or alphanumeric codes for specifying trade secrets is discussed in general in numerous locations within the specification (e.g., page 16, 30-34, etc.). As such, the typing of trade secrets by alphabetic, numeric, or alphanumeric codes is objectively enabled by the specification. Since the specification clearly enables the typing of trade secrets by alphabetic, numeric, or alphanumeric codes, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to typing trade secrets clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

6. Claims 1-95 have been rejected as being anticipated by Donner. In response, independent claims 1 and 71 have been limited to receipt of data from a trade secret applicant and to the context where said trade secret accounting and registration systems are only used for trade secret intellectual property. Support for these limitations may be found in numerous places within the specification. For example, the Field of the Invention is limited to describing only trade secret intellectual property. FIG. 1 shows only trade secret applications. The

receipt of data from a trade secret applicant may be found at page 6 of the specification.

In contrast, Donner is limited to patents that are found within an existing intellectual property portfolio. In addition, Donner is directed to placing a value on patents rather than to any process for accounting for trade secrets.

Since Donner is limited to placing a value on an existing portfolio of patents, Donner would have no reason to provide a data processing means for performing indexing of trade secrets. In addition, since Donner deals with an existing portfolio, Donner would also have no reason for providing a user interface means for entering data from a trade secret applicant.

Since Donner is limited to placing a value on an existing portfolio of patents, Donner does not do the same or any similar thing in the same way as that of the claimed invention. Since Donner does not do the same or any similar thing, the rejections are believed to be improper and should be withdrawn.

7. Claims 1-95 have been rejected as being anticipated by Elder. In response, independent claims 1 and 71 have been further limited to "user interface means for entering data from a trade secret applicant" and to the context "wherein said data processing means, user interface means and mass data storage means are only used for trade secret intellectual property".

In contrast, Elder fails to provide any teaching or suggestion of a "user interface means for entering data from a trade secret applicant". In addition Elder is explicitly directed to a method of and system for valuing elements of a business enterprise. Elder fails to provide any teaching of a system where "wherein said data processing means, user interface means and mass data storage means are only used for trade secret intellectual property"

The Examiner asserts that "The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art" (Office Action of 7/28/04, page 6). However, the claimed "data processing means for performing indexing of trade secrets, processing and storing data about or relating to trade secrets, and performing calculations about or relating to trade secrets" is not directed to an intended use of the trade secret accounting system; but, instead, is a description of the structural and functional features of the data processing means that differentiates the claimed data processing means from the data processing means of Elder.

In addition, the claimed context "wherein said data processing means, user interface means and mass data storage means are only used for trade secret intellectual property" is clearly descriptive of the structural and functional features of

the trade secret accounting system that differentiate these elements from Elder. Since Elder clearly fails to teach or suggest any of these features, Elder clearly does not do the same or any similar thing in the same way as that of the claimed invention. Since Elder fails to teach the same or any similar thing, the rejections are believed to be improper and should be withdrawn.

8. The allowance of claims 1-95 as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,

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